



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Christian BRONNER et al.

Title: ICBP90 POLYPEPTIDE AND ITS FRAGMENTS
AND POLYNUCLEOTIDES CODING FOR SAID
POLYPEPTIDES AND APPLICATIONS FOR
DIAGNOSING AND TREATING CANCER

Appl. No.: 10/019,071

Filing Date: 5/15/2002

Examiner: Minh-Tam DAVIS

Art Unit: 1642

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is in response to the restriction requirement set forth in the Office Action mailed June 25, 2004. Applicants enclose a Petition for a two-month Extension of Time and appropriate fee to make this response filed by September 25, 2004.

Applicants hereby provisionally elect Group 1-4 (claims 1-4), drawn to the polypeptides of SEQ ID NO: 2, 4, 6, and 8, for examination, **with traverse**. Applicants also provisionally elect SEQ ID NO: 2 for examination, **with traverse**.

Applicants traverse this restriction requirement on the grounds that the examiner has applied the wrong standard to the application. Applicants note that this application is a § 371 application of PCT/FR00/01747, and that the unity of invention standard must be applied in national stage applications. Section 1850 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) (hereinafter "MPEP") provides:

... [W]hen the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT

Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111....

In applying PCT Rule 13.2 to ... national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2....

Id. at page 1800-60 to -61.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

Examiners are reminded that unity of invention (not restriction) practice is applicable ... in national stage (filed under 35 U.S.C. 371) applications.

Id. at page 1800-149, column 1.

Indeed, according to Example 17, Part 2 of Annex B to the PCT Administrative Instructions, the Examiner is obliged to find that "[T]he protein and the DNA sequence exhibit corresponding special technical features" and that, therefore, there is no lack of unity between claims directed to a protein "X" and the DNA sequence that encodes protein "X."

Thus, in the present case, unity of invention does exist at least as between claims 1-4 (Group 1) and claims 5-8, 12, 24 and 26 (Group 5), which cover the polypeptides depicted in SEQ ID NO: 2 and the DNA depicted in SEQ ID NO: 1, which encodes that polypeptide. Accordingly, Applicants respectfully request that the examiner rejoin Groups 1 and 5, and examine their respective claims in a single application.

Also, according to Part 1(e)(i) of Annex B to the PCT Administrative Instructions, unity of invention permits inclusion of "an independent claim for a given product" and "an

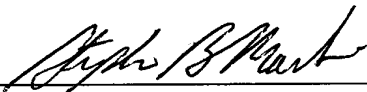
independent claim for a use of the said product" in the same application. Thus, in the present case, unity of invention also exists as between claims 5-8, 12, 24 and 26 (Group 5), claims 9-10, 23 and 25 (Group 9) and claim 11 (Group 13), which cover the polynucleotide depicted in SEQ ID NO: 1 and various uses of the polynucleotide depicted in SEQ ID NO: 1.

Accordingly, Applicants respectfully request that the examiner rejoin Groups 1, 5, 9 and 13, and examine their respective claims in a single application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date September 24, 2004

By 

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